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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,464	05/24/2001	Saverio C. Falco	BB1193 USDIV	3016

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4417 LANCASTER PIKE
WILMINGTON, DE 19805

EXAMINER

KERR, KATHLEEN M

ART UNIT

PAPER NUMBER

1652

DATE MAILED: 03/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/864,464

Applicant(s)

FALCO ET AL.

Examiner

Kathleen M Kerr

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 31-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 31-66 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Application Status

1. The instant Office action is in response to the preliminary amendment filed on May 24, 2001 (Paper No. 9) that cancelled original claims 1-30 and added new claims 31-66. The instant Office action is also response to the sequence listing filed on August 2, 2002.

Restriction

2. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

- I. Claims 31-43, drawn to polynucleotides encoding a *Zea mays* lysyl-tRNA synthetase (SEQ ID NOs: 9/10), chimeric genes, vectors, host cells, plants, seeds, and methods of transforming cells and producing plants, classified in class 435, subclass 419.
- II. Claims 31-43, drawn to polynucleotides encoding a *Glycine max* lysyl-tRNA synthetase (SEQ ID NOs: 13/14), chimeric genes, vectors, host cells, plants, seeds, and methods of transforming cells and producing plants, classified in class 435, subclass 419.
- III. Claims 31-43, drawn to polynucleotides encoding a *Triticum aestivum* lysyl-tRNA synthetase (SEQ ID NOs: 15/16), chimeric genes, vectors, host cells, plants, seeds, and methods of transforming cells and producing plants, classified in class 435, subclass 419.
- IV. Claims 55-66, drawn to polynucleotides encoding a *Oryza sativa* lysyl-tRNA synthetase (SEQ ID NOs: 11/12), chimeric genes, vectors, host cells, plants, seeds, and methods of transforming cells and producing plants, classified in class 435, subclass 419.

3. The inventions are distinct, each from the other because of the following reasons:

Groups I-IV drawn to polynucleotides encoding lysyl-tRNA synthetases from various plants. Each Group is classified identically. However, these Groups are distinct, each from the other, by virtue of their distinct structures. Each SEQ ID NO has a different structure that is unrelated, except via the function of the encoded enzyme, to the others. No consensus sequence describing the Groups is disclosed or claimed. Moreover, these polynucleotides from different sources are only described in the instant specification using their structures. Thus, each of these Groups, as defined by their structures, is patentably distinct from the others.

Moreover, a search of any two of the Groups would be undue considering not only the entirely distinct structure search that would not overlap whatsoever, but also the entirely distinct textual search in the non-patent literature which search would include the enzyme name and/or activity and the source. Concerning M.P.E.P. § 803.04 and the restriction of nucleotide sequences, the reasonable number of sequences in the instant application is *no more than one* due to the extensive searching required for nucleotide sequences encoding enzymes. Thus, restriction is proper.

Election

4. A telephone call was made to Kenneth Joung on March 24, 2003 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 C.F.R. § 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(i).

Conclusion

5. A complete response to the instant Office action must include an election of invention to be examined.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Kerr whose telephone number is (703) 305-1229. The examiner can normally be reached on Monday through Friday, from 8:30am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathupura Achutamurthy can be reached on (703) 308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

KMK
March 24, 2003

